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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/940,923

08/28/2001

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P01,0276

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01/13/2005

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EXAMINER

SHINGLES, KRISTIE D

ART UNIT

PAPER NUMBER

2141

DATE MAILED: 01/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/940,923

Applicant(s)

KIM ET AL.

Examiner

Kristie Shingles

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 28 August 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-37 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

*Claims 1-37 are pending.*

### ***Priority***

1. Acknowledgment is made of applicant's claim for domestic priority under 35 U.S.C. 120. The certified copy has been filed in Provisional Application No. 60/228,690, filed on 8/29/2000.

### ***Abstract***

2. The abstract of the disclosure is objected to for undue length in excess of 150 words. Correction is required. See MPEP § 608.01(b).

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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4. Claims 1, 17, 19, 20, 22, 23 and 26 are rejected under 35 U.S.C. 102(e) as being anticipated by *Rakavy et al* (USPN 6,317,789).

a. **Per claim 1, *Rakavy et al* teach a system of delivering information over a network including a server and a client, comprising:**

- a channel connecting the client to the server over which information is transmitted from the server to the client after activity on said channel has been determined to be below a predetermined threshold (**Col.13 Line 11-Col.14 Line 29; communication is established between the client and the Polite Agent Technology of the advertising system when the line utilization threshold is low—below the calculated threshold level for a predetermined percentage of time**);
- a storage at the client which stores the information transmitted from the server (**Abstract and Col.10 Lines 31-51; advertisements from the server may be stored on the user's local system**); and
- a program to present the information stored at the client to a user of the client (**Col.10 Line 30-Col.11 Line 63; the Advertisement Display Manager along with the User Interface Setup Process work to present and display the advertisement data to the user at the client device**).

b. **Per claim 17, *Rakavy et al* teach the system of claim 1, wherein the information delivered includes at least one of advertisements, multi media data, cartoons, study materials, and news broadcasts (Col.3 Lines 42-51, Col.4 Lines 1-4, Col.15 Lines 1-10 and 30-35; the delivered data comprises a variety of types, including advertisements, news, weather and multimedia).**

c. **Per claim 19, *Rakavy et al* teach the system of claim 1, further comprising: a catalog in which the information is arranged in a hierarchical table by contents and a user can browse the table and select and display an entry of the table (Col.9 Lines 45-51 and Col.10 Lines 5-9 and 31-51; user's may browse through a menu of the advertisements, categorized**

**according to their preference, and make selections from the menu for the advertisements to display).**

d. **Per claim 20, Rakavy et al** teach the system of claim 19, wherein said catalog is started when one of: a user clicks information being presented, a user clicks a banner that is integrated with a information being presented, and a user clicks an icon linked with the catalog (Col.10 Lines 39-48; **the user selects the advertisement to be presented from the menu, “clicking” is implied in the selection**).

e. **Per claim 22, Rakavy et al** teach the system of claim 19, wherein said catalog is accessible both online and offline (Col.10 Lines 31-51; **the advertisement menu may be downloaded and stored on the network or on storage media at a local advertisement database—the menu stored on the storage media is accessible offline, the menu stored on the network may be accessible online**).

f. **Per claim 23, Rakavy et al** teach the system of claim 19, wherein said catalog categorizes the information stored in the client by their contents, deletes materials that are expired, and updates information by the server (Col.10 Lines 5-51 and Col.12 Lines 60-67; **in the menu the categorized preferences of the user are contained, advertisements may be categorized according to the advertiser, advertisements are purged, and updates are synchronized with the server**).

g. **Per claim 26, Rakavy et al** teach the system of claim 19, wherein the client reports to the server contents of the information stored in said storage and usage of the information by said program and keywords extracted from a user's activity, the keywords include a URL that the user clicks or types and words in text associated with a link that the user clicks,

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and said usage of information includes the presentation time and times of each material, and a time and number of user clicks for each entry of the catalog (**Col.3 Lines 52-59 and Col.5 Lines 42-63 and Col.6 Line 31-40; the Job Manager creates a Network Job for each user where their activity and participation is tracked, feedback is maintained and preferenced/configuration data are analyzed**).

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims **2-16, 25 and 28-37** are rejected under 35 U.S.C. 103(a) as being unpatentable over *Rakavy et al* (USPN 6,317,789) in view of *Bruck et al* (USPN 6,237,022).

a. **Per claim 2**, *Rakavy et al* teach the system of claim 1 as applied above, yet fail to explicitly teach the system of claim 1, wherein said information is non-requested information, and further comprising: a timer component of said program which monitors a time gap between a request by a user for a requested item of information and arrival of said requested item of information at the client, said timer component initiating presentation of said non-requested information at said client if the time gap is bigger than a threshold value, said timer component stopping presentation of said non-requested when one of said item of requested information

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arrives at said client and a predetermined time elapses. However, *Bruck et al* teach a timing component wherein periods of time are monitored and the advertisement/non-requested data may begin transfer to the client after the first period of idle time, but stop when the second period of idle time begins—download waiting time, when a user issues a request for data and ends once all of the requested data is downloaded, then the second period of idle time is over (**Col.7 Line 40-Col.9 Line 14**).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of *Rakavy et al* and *Bruck et al* for the purpose of permitting a hierarchical scheme for downloading the advertisements; because it would allow the user to continue performing tasks and interacting with their computing device without being limited due to the arrival/downloading of any non-requested data. In this way, the non-requested data (i.e., advertisements) would not interfere with or interrupt the processing and speed of the user's own initiated interactions with their computing device.

b. **Per claim 3**, *Bruck et al* teach the system of claim 2, wherein said storage stores a plurality of items of non-requested information, and further comprising: a selection component of said program which selects for presentation an item of said non-requested information stored in said storage by multiple matching (**Col.11 Lines 25-44 and Col.12 Lines 10-21; user-preference data is matched to data from data feeds stored in the information server**).

c. **Per claim 4**, *Bruck et al* teach the system of claim 3, wherein said selection component presents said item of said non-requested information for presentation only if a predetermined interval has elapsed after a previous presentation (**Col.10 Lines 40-50; in**

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**multiple data presentations of non-requested data the browsing device waits until the detection of another period of idle time before presenting the successive data presentation).**

d. **Claim 14** is substantially similar to claim 4 and is therefore rejected under the same basis.

e. **Per claim 5, *Bruck et al* teach the system of claim 4, wherein said predetermined interval is controlled by one of the server and the client (Col.9 Lines 43-53 and Col.10 Lines 51-59; the predetermined time period may be controlled by the server and communicated to the browsing device/client).**

f. **Claim 15** is substantially similar to claim 5 and is therefore rejected under the same basis.

g. **Per claim 6, *Bruck et al* teach the system of claim 3, wherein said multiple matching matches the non-requested information with a keyword that the client detects from a user's activity (Col.12 Lines 14-21; keywords of the user's preferred data may be matched with data from the data feeds).**

h. **Per claim 7, *Bruck et al* teach the system of claim 6, wherein said keyword includes a URL that the user clicks or types and words in a text associated with a link that the user clicks (Col.6 Lines 51-60, Col.7 Lines 9-16 and Col.9 Lines 15-34; a URL may be selected by the user that identifies data related to the user's preferences or the data feeds).**

i. **Per claim 8, *Bruck et al* teach the system of claim 6, wherein said selection component selects part of the non-requested information as targeted for a user's preference that is determined by the keywords (Col.8 Lines 3-26, Col.11 Lines 30-44 and Col.12 Lines 14-21;**



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**selection of the advertisements is based upon designated criteria which could be based on keyword matching from the user's preferences).**

j. **Per claim 9, *Bruck et al* teach the system of claim 8, wherein targeted information and untargeted information are presented randomly (Col.7 Lines 17-25 and Col.12 Lines 41-47; any combination of the advertising data and the preferenced may be selected for alternating between displaying transition pages of preferenced data and advertising data).**

k. **Per claim 10, *Bruck et al* teach the system of claim 3, wherein an urgent item of information is presented without matching (Col.2 Lines 32-36; "push technology", a well-known practice in the art, comprises presenting information—which may be urgent—to a device without necessarily matching with a user's request or preference).**

l. **Per claim 16, *Bruck et al* teach the system of claim 3, wherein an item of information is presented within predetermined presentation times (Col.9 Line 43-Col.10 Line 66; advertisements may be presented at predetermined idle times).**

m. **Per claim 25, *Bruck et al* teach the system of claim 2, wherein the client reports to the server contents of the information stored in said storage and usage of the information by said program and keywords extracted from a user's activity (Col.11 Lines 7-Col.12 Lines 21; the user preferences and data matched from data feeds are transmitted and stored at the server).**

n. **Per claim 28, *Bruck et al* teach the system of claim 2, wherein the server is a web server, and the client is a computer program in a user's computer (Col.3 Line 65-Col.4 Line 5,**

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**Col.5 Lines 18-49 and Col.6 Lines 28-60; system comprises manipulation of web server access and of a computer program on the client device).**

o. **Per claim 30, *Bruck et al* teach the system of claim 28, wherein said program displays the information in a web-browser's window (Col.7 Lines 12-35; advertisement is displayed in the web-browser window of the browsing device).**

p. **Per claim 34, *Bruck et al* teach the system of claim 28, wherein said program includes a dial-up networking function (Col.2 Lines 8-21, Col.4 Lines 41-59 and Col.6 Lines 1-27; dial-up network function implicit with modem use).**

q. **Per claim 31, *Bruck et al* teach the system of claim 30, wherein the information is displayed in full-window (Col.9 Line 54-Col.10 Line 13; the transition page may be displayed in different formats, either opaquely or partially translucent; wherein no other web-page can be seen through it or such that the destination web page is partially visible).**

r. **Per claim 32, *Bruck et al* teach the system of claim 30, wherein the information is displayed in partial-window (Col.9 Line 54-Col.10 Line 13; the transition page may be displayed in different formats, either opaquely or partially translucent; wherein no other web-page can be seen through it or such that the destination web page is partially visible).**

s. **Per claim 35, *Bruck et al* teach the system of claim 28, wherein said program is activated automatically when a web-browser is activated (Col.7 Line 9-Col.8 Line 64 and Col.12 Lines 1-67; the system is activated during web-browsing activities wherein the web-browser is monitored for idle time periods of temporary inactivity).**

t. **Per claim 11, *Bruck et al* teach the system claim 6 as applied above, yet fail to distinctly teach the system of claim 6 wherein a material that has the highest priority is selected**

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among plural matches. However, *Rakavy et al* teach displaying advertisements matching the user's high priority categories (Col.10 Lines 5-15).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of *Bruck et al* and *Rakavy et al* for the purpose of selecting advertisements according to the highest priority ranking of the user's preferred data matched with the advertisement data; because it would allow for the display of advertisements that are most relevant to the user's preferences which would most likely increase the effectiveness of the advertisement.

u. **Per claim 12, *Rakavy et al* teach the system of claim 11, wherein priority for an item of information increases as a time during which the item of information is not presented increases (Col.7 Lines 53-63, Col.9 Lines 45-51 and Col.10 Lines 8-13; priority increases for the lower priority advertisements as the higher priority advertisements are displayed).**

v. **Claim 13** is substantially similar to claim 12 and is therefore rejected under the same basis.

w. **Per claim 29, *Bruck et al* teach the system of claim 28 as applied above, yet fail to explicitly teach the system of claim 28, wherein said program displays the information separately from a web-browser's window. However, *Rakavy et al* teach displaying advertisements in background wallpaper (Col.3 Lines 35-41 and Col.11 Lines 1-5 and 54-67).**

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of *Bruck et al* and *Rakavy et al* for the purpose of displaying the advertisement separately from the web-browser; because it would allow the

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advertisements to be displayed in another mode without occupying the use of the web-browser, thus the user's web browsing activities would not be interrupted.

x. **Claim 33** is substantially similar to claim 29 and is therefore rejected under the same basis.

y. **Per claim 36**, *Rakavy et al* teach the method of transmitting information to the client from the server when a channel connecting the client and the server is at an activity level below a predetermined threshold and storing the information in the client—as applied above in claim 1. Yet *Rakavy et al* fail to distinctly teach presenting the information to a user of the client when a time gap between the user's request for material and arrival of material is longer than a predetermined threshold value. However, *Bruck et al* disclose displaying advertisement data to the user during an idle time period between the user receiving downloaded information, obtaining communication with the server and time gaps of inactivity (Col.7 Line 10-Col.9 Line 53).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of *Bruck et al* and *Rakavy et al* for the purpose of presenting the non-requested advertisement data to the user during the time period the user waits for a response/reply or fulfillment of their request; because it would allow the advertisements to be displayed in a manner non-disruptive to the user's initiated activities while permitting the advertisements to make use of idle time spent waiting for a connection, a reply, or a request fulfillment.

z. **Claim 37** is substantially similar to claim 19 and is therefore rejected under the same basis.

7. Claims **18 and 27** are rejected under 35 U.S.C. 103(a) as being unpatentable over *Bruck et al* (USPN 6,237,022) in view of *Radziewicz et al* (USPN 5,854,897).

a. **Per claim 18**, *Bruck et al* teach the system of claim 2 as applied above, yet fail to explicitly teach the system of claim 2, wherein said program presents a banner related to the presented non-requested information integrated into the requested item of information. However, *Radziewicz et al* teach a system presenting views of the advertisement data in the announcement window portion integrated within the browser display area (**Figures 8A-8D, Col.5 Line 49-Col.6 Line 12, Col.12 Line 44-Col.14 Line 62, Col.21 Lines 6-24 and Col.24 Line 46-Col.25 Line 7**).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of *Bruck et al* and *Radziewicz et al* for the purpose of integrating a banner into a display area of the web-browser; because it would allow the advertisements to be presented to the user while the user is engaged in other browsing activity. This way, the advertisement would use estate on the web-browser window without needing a separate browser window.

b. **Per claim 27**, *Bruck et al* teach the system of claim 25 as applied above yet fail to explicitly teach the system of claim 25, wherein the client report is performed in real-time. However, *Radziewicz et al* disclose real-time communication within the advertising network system (**Col.4 Lines 29-49, Col.8 Lines 16-44, Col.12 Lines 46-61 and Col.20 Lines 19-43**).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of *Bruck et al* and *Radziewicz et al* for the purpose

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of allowing real-time reporting of the client's activities with the advertisement data, because it provides instant updates as the program is being used and provides more precise statistical results regarding the interaction between the user and the program.

8. Claims **21 and 24** are rejected under 35 U.S.C. 103(a) as being unpatentable over *Rakavy et al* (USPN 6,317,789) in view of *Hoyle* (USPN 6,771,290).

a. **Per claim 21**, *Rakavy et al* teach the system of claim 19 as applied above, yet fail to explicitly teach the system of claim 19, wherein the entry includes information presented by the system, further information attached to the information, and a web site whose URL is embedded in the information. However, *Hoyle* discloses menus of advertising data including hypertext links and URLs for the user to interact with the advertisements (**Col.14 Lines 38-51 and Col.15 Line 26-Col.16 Line 14**).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of *Rakavy et al* and *Hoyle* for the purpose of providing additional access information in the catalog/list/menu with the advertisements; because the user would be able to contact the advertisement's website directly via the embedded URL without the need for displaying the actual visual advertisement itself.

b. **Per claim 24**, *Rakavy et al* teach the system of claim 19 as applied above, yet fail to explicitly teach the system of claim 19, wherein said catalog includes a toolbar that is configurable by at least one of the client and the server. However, *Hoyle* discloses

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implementation of a toolbar with the menu of advertised data; the icons of the toolbar are customizable by the client and/or server (**Col.13 Line 48-Col.16 Line 30**).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of *Rakavy et al* and *Hoyle* for the purpose of visual organization of the presentable data; because the user would be able to customize and configure the advertising based on the particular options present on the toolbar. Furthermore, toolbars offer user-friendly interfaces with icons that assist in accessing and modifying data according to one's preference.

### ***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a. *Wine et al* (US 20020004839) disclose a method of controlling the display of a browser during a transmission of a multimedia stream over an Internet connection so as to create a synchronized convergence platform.
- b. *Gabbard et al* (USPN 6,205,432) disclose a background advertising system.
- c. *Borman et al* (USPN 6,606,654) disclose a link delivery for subsequent retrieval of networked information.
- d. *Bates et al* (USPN 6,760,048) disclose a display of occluded display elements on a computer display.
- e. *Samar* (USPN 6,563,514) discloses a system and method for providing contextual and dynamic information retrieval.
- f. *Hoyle* (USPN 6,141,010) discloses a computer interface method and apparatus with targeted advertising.

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10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kristie Shingles whose telephone number is 571-272-3888. The examiner can normally be reached on Monday-Friday 8:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rupal Dharia can be reached on 571-272-3880. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Kristie Shingles  
Examiner  
Art Unit 2141

kds

  
RUPAL DHARIA  
SUPERVISORY PATENT EXAMINER